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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/764,559	04/21/2010	Kristen DOHERTY	T9049-19648US01	7584

74739 7590 01/17/2018

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EXAMINER

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ART UNIT	PAPER NUMBER
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3687

NOTIFICATION DATE	DELIVERY MODE
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01/17/2018

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KRISTEN DOHERTY, NIGEL KING, and
DANIELA KANTOROVA

Appeal 2016-001831
Application 12/764,559¹
Technology Center 3600

Before BRUCE T. WIEDER, BRADLEY B. BAYAT, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1–3, 6–11, 13–15, and 17–23. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ According to Appellants, the real party in interest is Oracle International Corporation. (Appeal Br. 3.)

CLAIMED SUBJECT MATTER

Appellants' claimed invention relates to "record[ing] business transactions." (Spec. ¶ 1.)

Claims 1, 9, and 13 are the independent claims on appeal. We select claim 9 as representative. It recites:

9. A computer implemented method comprising:
 - storing a plurality of business objects in a database;
 - receiving, by a processor, a business object to be changed, a change type, and an effective date of the change;
 - identifying a number of impacted transactions associated with each transaction category of the business object, including:
 - identifying transactions directly associated with each transaction category of the business object; and
 - identifying transactions not directly associated with each transaction category of the business object but that may be posted to the business object in the future;
 - displaying, in a first user interface, the transaction categories of the business object, the number of impacted transactions in each transaction category, and the percentage of impacted transactions that have been reviewed in each transaction category; and
 - displaying, in a second user interface in response to receiving a selection of a transaction category, a plurality of transaction types for the selected transaction category, the number of impacted transactions for each transaction type, an indication of whether action is required for each transaction type, and the percentage of impacted transactions that have been reviewed for each transaction type.

REJECTION

Claims 1–3, 6–11, 13–15, and 17–23 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

ANALYSIS

In 2014, the Supreme Court decided *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). *Alice* applies a two-part framework, earlier set out in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

Under the two-part framework, it must first be determined if “the claims at issue are directed to a patent-ineligible concept.” *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second part of the framework is applied to determine if “the elements of the claim . . . contain[] an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 2357 (citing *Mayo*, 566 U.S. at 72–73, 79).

Under part one of the *Alice* framework, we “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)). Thus, although we consider the claim as a whole, the “directed to” inquiry focuses on the claim’s “character as a whole.”

The Specification provides evidence as to what the invention is directed. In this case, the Specification discloses that the invention is directed “to a financial computer system that records business transactions.” (Spec. ¶ 1.) The Specification also discloses that “cost centers” and “profit centers” are “business objects.” (*Id.* ¶ 2.)

Further with regard to part one of the *Alice* framework, the Examiner determines that the claims are “directed to the abstract idea of determining and reporting transactions impacted by organization changes.” (Final Action 4.)

Although Appellants disagree with the Examiner’s characterization of the abstract idea (Appeal Br. 8), Appellants acknowledge that

independent Claims 1, 9 and 13 are directed to a nontransitory computer readable medium, a method and a system, respectively, “that, in response to receiving a business object to be changed, a change type, and an effective date of the change, identifies all first transactions directly associated with the business object and identifies all second transactions not directly associated with the business object but that may be posted to the business object in the future. The system then displays the first transactions and the second transactions in a user interface.” *See, e.g.,* Specification at Paragraph 0004, etc.

(*Id.* at 5.) In other words, with regard to, e.g., a cost center to be changed, the claims are directed to a method for identifying transactions associated (both directly and not directly) with the cost center and displaying the transactions in a user interface. In short, “[t]he focus of the asserted claims . . . is on collecting information, analyzing it, and displaying certain results of the collection and analysis.” *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). “Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Id.*

Although the Examiner and Appellants describe, at different levels of abstraction, to what the claims are directed, we note that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v.*

Ameranth, Inc., 842 F.3d 1229, 1240 (Fed. Cir. 2016). However, that need not and, in this case does not, “impact the patentability analysis.” *See id.* at 1241. We are not persuaded that the Examiner erred in determining that the claims are “directed to the abstract idea of determining and reporting transactions impacted by organization changes.” (Final Action 4.)

Appellants further argue that the Examiner “failed to establish a *prima facie* case that the claims are directed to an abstract idea.” (Appeal Br. 9.) We disagree.

[T]he PTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant . . . [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. That section “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed.Cir.1990).

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Here, the Examiner analyzed the claims using the *Alice* framework and clearly articulated why the claims are directed to an abstract idea. (*See* Final Action 3–4; *see also* Answer 2–5.)

Part two of the *Alice* framework has been described “as a search for an ‘“inventive concept” ’ –i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 72–73).

The introduction of a computer or processor into the claim does not alter the analysis in part two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’ ” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “ ‘to a particular technological environment.’ ” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional featur[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Id. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Id.* at 2359. They do not. Although Appellants argue that “the claimed invention clearly ‘improve[] an existing technological process’” (Appeal Br. 12, alteration in original; *see also id.* at 13–14), we disagree. “These claims in substance [are] directed to nothing more than the performance of an abstract business practice . . . using a conventional computer. Such claims are not patent-eligible.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

Appellants further argue that “the recited claims do not attempt to preempt every application of ‘determining and reporting transactions impacted by organizational changes.’” (Appeal Br. 11.) However, we are not persuaded of error. Preemption is not a separate test.

To be clear, the proper focus is not preemption *per se*, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly *less*. *See Mayo* 132 S. Ct. at 1294 [566 U.S. at 72–73].

CLS Bank Int’l v. Alice Corp. Pty. Ltd., 717 F.3d 1269, 1281 (Fed. Cir. 2013) (Lourie, J., concurring), *aff’d*, 134 S. Ct. 2347 (2014). Moreover, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). In other words, “preemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Moreover, taking the claim elements separately, the function performed by the computer at each step is purely conventional. Collecting, analyzing, and displaying data are basic computer functions. Additionally, the Specification discloses that the invention can be implemented using generic computer components. (*See, e.g.*, Spec. ¶ 13.) In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellants’ method add nothing that is not already present when the steps

are considered separately. The claims do not, for example, purport to improve the functioning of the processor itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of determining and reporting transactions impacted by organizational changes using some unspecified, generic computer. That is not enough to transform an abstract idea into a patent-eligible invention. *Alice*, 134 S. Ct. at 2360.

For the reasons discussed above, we are not persuaded that the Examiner erred in rejecting claim 9 under § 101. Appellants do not separately argue claims 1–3, 6–8, 10, 11, 13–15, and 17–23. These claims fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

The Examiner’s rejection of claims 1–3, 6–11, 13–15, and 17–23 under 35 U.S.C. § 101 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED